

Docket No. F-7179

Ser. No. 09/989,285

**REMARKS**

The above amendments and following remarks are responsive to the Office Action of January 4, 2005. Reconsideration of the application and a notice of allowance are earnestly solicited.

Claims 1-9 are pending in the application and each has been rejected under 35 U.S.C. §102 (e) as being anticipated by Bromberg et al. (U.S. Patent No. 6,529,889 B1). The following represents further details of the rejection.

Claims 1, 3, 7 and 8 are each rejected, in whole or in part, based on Bromberg's implicit or inherent disclosure. Specifically, regarding Claim 1, the Examiner asserts that Bromberg implicitly teaches in column 25, lines 64-67 evaluating a person based on four evaluation templates. Regarding Claim 3, the Examiner asserts that Bromberg inherently teaches a tacit knowledge expression template that is read and output by a computer as a reference syntax for expressing tacit knowledge in the externalization process. Regarding Claim 7, the Examiner asserts that Bromberg implicitly teaches in column 24, lines 44-60, a database managed by a knowledge consultant that contains accumulated intellectual resource data gained by making a contract between the knowledge consultant and an owner of intellectual property. Regarding Claim 8, the Examiner asserts that Bromberg implicitly teaches in column 25, lines 64-67 a manager that manages a database and one or more organizations acting as a

07/06/2005 BBONNER 00000032 09989285

01-PC-1253

1020.00 OP

Docket No. F-7179

Ser. No. 09/989,285

knowledge consultant having a server accessible to the database through a two-way communication network, and a customer organization that has a computer that works as a client of the server of the knowledge consultant by accessing thereto through a two-way communication network, and where the database contains different templates available for the customer through access to the server.

Regarding Claim 4, the Examiner asserts that column 5, lines 27-40, column 23, lines 57-64 and column 24, lines 29-33 collectively teach a glossary as recited in the claim.

Applicant traverses the rejections as follows.

In reviewing the present invention against Bromberg, the reference fails to teach the glossary recited in Claim 4. Specifically, the present invention teaches, on page 12, second paragraph, that the glossary is adapted for providing terms for responding to inquiries so that tacit knowledge can be converted into explicit knowledge in a format common to the entire organization. On the other hand, the locations in Bromberg cited by the Examiner in the rejection against Claim 4 teach that questions provided to the user/professional in Bromberg are formed using particular words or phrases. Bromberg is silent regarding the answers received by the user.

Docket No. F-7179

Ser. No. 09/989,285

Accordingly, Applicant has amended claims 1 and 2 to recite the limitations of claims 3 and 4 and to recite that the glossary provides terms for responding to inquiries so that tacit knowledge is converted into explicit knowledge in a common format. Applicant has also cancelled claims 3 and 4.

Regarding the rejections based on implicit and inherent disclosure of Blomberg, Applicant disagrees with the Examiner as follows.

To establish that a reference implicitly teaches limitations recited in a claim, the limitations must necessarily be present in the reference. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (a reference cannot be used to establish merely the possibility of the existence of the limitation; the mere fact that the limitation may exist is not sufficient).

Regarding Claim 1, there is nothing in Bromberg's dynamic form taught in column 25, lines 64-67 that necessitates evaluating a person based on four templates. Regarding Claim 3, there is nothing about Bromberg, as a whole, that necessitates the tacit knowledge expression template that is used as a reference syntax for expressing knowledge in the externalization process. Regarding Claim 7, there is nothing about the mentioning of a contract identifier in column 24, lines 44-60 of Bromberg that necessitates managing accumulated intellectual property. Regarding Claim 8, there is nothing in Bromberg's dynamic form taught in column 25, lines 64-67 that necessitates one

Docket No. F-7179

Ser. No. 09/989,285

organization acting as a knowledge consultant and a customer organization acting as a client thereof by accessing a database containing different templates through a two-way communication network. Accordingly, the rejection of claims 1, 3, 7 and 8 is improper.

Applicant respectfully requests a three month extension of time for responding to the Office Action. The fee of \$1020.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Docket No. F-7179

Ser. No. 09/989,285

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

and,

By T. David Bomzer  
T. David Bomzer  
Reg. No. 48,770  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340